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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,890	01/23/2002	Yehouda Harpaz		8217

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EXAMINER

MARKS, CHRISTINA M

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 05/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/031,890	<b>Applicant(s)</b> HARPAZ, YEHOUDA	
	<b>Examiner</b> C. Marks	<b>Art Unit</b> 3713	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3 and 4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3 and 4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

While a search report and documents were included with the patent application, a proper IDS form was not filed in accordance with 37 C.F.R. §1.97 and §1.98. The Examiner has considered the documents; however, as they were included in the file, it is requisite that a proper IDS be filed for them to be properly associated with the case. The Examiner suggests the Applicant review 37 CFR § 1.56 regarding the duty to disclose information.

### ***Drawings***

The objection to the drawings has been withdrawn due to the amendment filed 23 January 2004 removing limitations that were not properly illustrated.

### ***Claim Objections***

The objection to claim1 -2 has been withdrawn due to the correction of the deficiencies in the amendment filed 23 January 2004.

As a note to the Applicant, the Office has renumbered newly submitted claims as 3 and 4 respectively. When claims are cancelled, their claims numbers cannot be replaced by new claims. The new claims must start the numbering where the old claims left off. For more information on claims, the Examiner invites the Applicant to review 37 C.F.R. § 1.75

***Claim Rejections - 35 USC § 101***

The rejection of claims 1-2 for containing non-statutory subject matter has been withdrawn due to the cancellation of the claims and the absence of the computer program in the amended claims.

***Claim Rejections - 35 USC § 112***

The rejection of claims 1-2 indefiniteness has been withdrawn due to the cancellation of the claims and the absence of the computer program in the amended claims.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It does not appear to be specifically disclosed that when an un-illuminated grid point is pressed that points are illuminated in the player's color and are one point away from the pressed point on a line of the grid or a 45 degree diagonal became illuminated. Further, it does not appear to be disclosed that the pressed points and all other points that are 1 or 2 points away are also illuminated on a line or 45 degree angle. The specific limitations are not disclosed in the specification in the same restrictive detail in which they are claimed and thus are new matter.

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Applicant is invited to provide explicit support for the limitations by identifying the page and line number where the limitations are unambiguously supported if such support does exist.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 3-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Blumberg et al. (US Patent No. 5,417,425).

Blumberg et al. disclose a grid of grid points on a flat surface where each grid point is a visible element (FIG 1-4) which is capable of detecting when it is pressed (Column 1, lines 22-30). Blumberg et al. also disclose an illumination source inside and below the surface which is capable of illuminating the visible element (FIGs 13-14) by either of two colors (Column 6, lines 37-40).

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitation *Ex parte Masham*, 2 USPQ2d 1647 (1987). A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Thus, in the structural claim dictated by claims 1 and 2 the Blumberg et al. device is capable of being used to play a variety of games and programming

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the device to be used in a different manner would not result in a structural difference, only a difference of a software program executed by the processor. Hence the recitation that the device be employed to play a variety of games as well as an example of such a game does not differentiate the claimed apparatus from the Blumberg et al. apparatus which satisfies the claimed structural limitation.

### ***Response to Arguments***

As a note to Applicant, remarks should be included under their own heading named Remarks in future correspondence.

In response to the Applicant's argument that the novel part of claim 1 is its last two-thirds, the Examiner respectfully invites the Applicant to review the above rejection which details that the last two-thirds is an intended use recitation. Even though the Applicant asserts that the part is a description of the behavior of the board and is thus patentable, the Examiner reminds the Applicant that the claim is that to a structure, not a method. Structure claims do not embody the usages of the structure; they are drawn only to the actual structural parts of the invention. As disclosed above, if the prior art structures are capable of employing the intended use, the claimed apparatus is not differentiated from the prior art device.

Regarding the Applicant's argument that Blumberg et al. is a completely different construction, the Examiner respectfully disagrees as the structure embodies that which is listed in the claim limitations. As per the claim language being drawn towards a two-player game, the Examiner contends that argument is not coterminous with the actual claim language as only one player is actually mention and there is not explicit distinction of more than one player being required.

Regarding the Applicant's arguments regarding the usage of Blumberg et al., the Examiner reminds the Applicant that in a structure claim the intended usage of the device is not patently distinguishable over prior art devices with the same structure.

Regarding the Applicant's arguments as to why the combination of references is not obvious, the Examiner respectfully submits that the argument is moot in view of the newly formed rejection. Further, the arguments are drawn to the usage of the device and thus are not coterminous with the actual structure claim language.

Regarding the Applicant's argument that the board of Blumberg et al. is not "desktop", the Examiner respectfully disagreed. First, there is no recitation of the explicit limitation in the claims and further a skilled artisan is more than capable of understanding the device can be set on a table and played and that holding the device is not essential to it being played. If set on a table the device will still operate perfectly and be able to perform its functionality.

Regarding the Applicant's argument about making the board larger, the Examiner reminds the Applicant that applications are examined on the merits of the *claims* not the entire disclosure of the specification, thus the argument is not pertinent to the actual claim language.

Regarding the Applicant's argument relating to the cost of the device, the argument is conclusionary and is thus not persuasive. An opinion is not a solid case for establishing non-obviousness. The Examiner suggests the Applicant review 37 CFR §1.132 in order for such statements to be properly considered.

Regarding Applicant's arguments about how Othello is different than the claimed game, the Examiner again notes the intended usage of the device is being argued.

Finally, the Examiner wishes to remind the Applicants that in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies as detailed above are not recited in the rejected

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claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### **Conclusion**

This action is a **final rejection** and is intended to close the prosecution of this application. Applicant's reply under 37 CFR 1.113 to this action is limited either to an appeal to the Board of Patent Appeals and Interferences or to an amendment complying with the requirements set forth below.

If applicant should desire to appeal any rejection made by the examiner, a Notice of Appeal must be filed within the period for reply identifying the rejected claim or claims appealed. The Notice of Appeal must be accompanied by the required appeal fee of \$160.00.

If applicant should desire to file an amendment, entry of a proposed amendment after final rejection cannot be made as a matter of right unless it merely cancels claims or complies with a formal requirement made earlier. Amendments touching the merits of the application which otherwise might not be proper may be admitted upon a showing a good and sufficient reasons why they are necessary and why they were not presented earlier.

A reply under 37 CFR 1.113 to a final rejection must include the appeal from, or cancellation of, each rejected claim. The filing of an amendment after final rejection, whether or not it is entered, does not stop the running of the statutory period for reply to the final rejection unless the examiner holds the claims to be in condition for allowance. Accordingly, if a Notice of Appeal has not been filed properly within the period for reply, or any extension of this period obtained under either 37 CFR 1.136(a) or (b), the application will become abandoned.



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa J Walberg can be reached on (703)-308-1327. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



cmm

May 13, 2004



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